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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,195	09/17/2003	Todd M. Bjork	M81.12-0068	3894

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3733

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/664,195

Applicant(s)

BJORK ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10, 15, 17-25 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 4-7, 11-14, 16 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/17/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/732,491. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claim of the present application and the claim of the copending application is that the claim of the copending application includes more elements and is thus more specific. Thus the invention of claim 1 of the copending application is in effect a "species" of the "generic" invention of claim 1 of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claim of the present application is anticipated by the claim of the copending

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application, it is not patentably distinct from the claim of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-10, 15, 17, 19, 21-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Farley et al. (US 6,033,363).

Farley et al. disclose a surgical joint 21 including a first clamping member 52, a second clamping member 54, a shaft 56 disposed through an attachment end of first clamping member 52 and communicating with the second clamping member and a wedge member or “actuating mechanism” or “force providing mechanism” 60 disposed about shaft 56 to ensure adequate constriction of each clamping member and a cam lever or “handle” 58 attached to the actuating mechanism (Figures 3 and 6, col. 2, lines 49-67 and col. 3, lines 1-41).

Claims 15 and 17-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobrovolny (US 5,727,899).

Regarding claims 15 and 17-19, Dobrovolny discloses a clamping member with a clamping portion 150, first and second leg portions 160, 162, a wedge 164

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disposed between the first and second leg portions and a handle 120 attached to wedge 164 (Fig. 4 and col. 4, lines 34-49).

Regarding claims 20-27, Dobrovolny further discloses that clamping portion 150 can have a clamping member 12 rotatably attached to clamping portion 150 wherein the clamping member is positioned in a clamping position by movement of the wedge about the fulcrum (Fig. 2).

Claims 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips (US 2003/0191370A1).

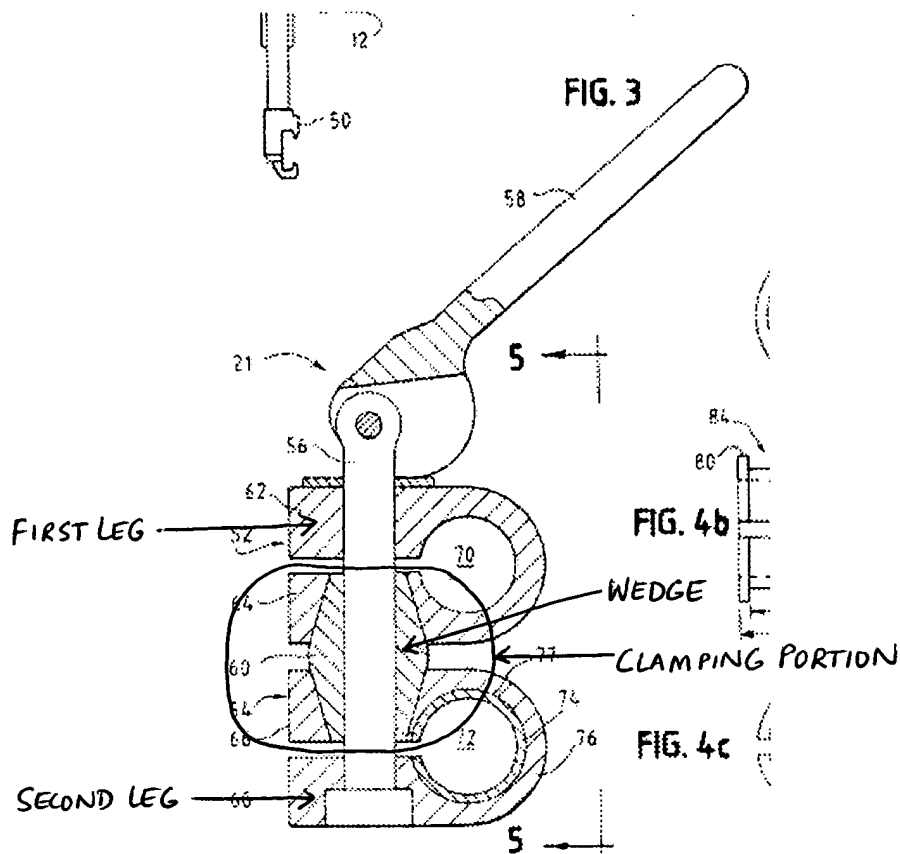
Phillips discloses a clamp having a pin 20 extending through the clamp member into a clamping cavity, an activating mechanism 28 that biases pin 20 into the clamping cavity and a wedge member 40 that is used to apply a force to pin 20 (Fig. 2, paras [0017] - [0020]).

### ***Response to Arguments***

Applicant's arguments and claim amendments filed on April 13, 2005 have been fully considered but are not persuasive for the following reasons.

Regarding the rejections of claims 1 and 9 under 35 USC 102(b) by Farley et al., the wedge member or "actuating mechanism" 60 of Farley et al. is disposed in the intervening space or "between" the first and second clamping members and has a handle 58 attached or "connected" thereto via shaft 56 (Fig. 3).

Regarding the rejection of claim 15 under 35 USC 102(b) by Farley et al., wedge 60 of Farley et al. forces the legs of each of the clamping members towards each other, i.e., in opposing directions. See Fig. 3 from Farley et al. marked up on the following page to clarify Examiner's interpretation of Farley et al.



Regarding the rejection of claim 21 under 35 USC 102(b) by Farley et al., lacking an explicit definition, "a central axis" is being broadly interpreted as a lateral axis of each elongated member.

Regarding the rejection of claim 15 under 35 USC 102(b) by Dobrovolny, fulcrum 164 is a wedge since it has two principal faces roughly meeting at an acute angle.

Regarding the rejection of claim 21 under 35 USC 102(b) by Dobrovolny, lacking an explicit definition, "a central axis" is being broadly interpreted as a lateral axis of each elongated member. Notwithstanding this, the legs of the Dobrovolny clamping members are resilient thus one could insert an elongated member in the clamping cavity of each clamping member in a generally orthogonal direction to the longitudinal axis of the elongated member, if required in a particular application.

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Regarding the rejection of claim 28 under 35 USC 102(e) by Phillips, spring 28 is positioned about, i.e., near, pin 20.

### ***Allowable Subject Matter***

Claims 4-7, 11-14, 16 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Armando Ramana*  
February 28, 2006

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER